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September 25, 2003

Paper No. 11

GDH/gdh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Charter One Financial, Inc.

Serial No. 76/362,677

Robert V. Vickers of Fay, Sharpe, Fagan, Minnich & McKee for
Charter One Financial, Inc.

Ronald McMorrow, Trademark Examining Attorney, Law Office 105
(Thomas G. Howell, Managing Attorney).

Before Hohein, Hairston and Bucher, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Charter One Financial, Inc. has filed an application
to register the mark "BUSINESS ONE REWARDS" for "banking
services."¹

¹ Ser. No. 76/362,677, filed on January 25, 2002, which is based on an
allegation of a bona fide intention to use the mark in commerce. The
words "BUSINESS" and "REWARDS" are disclaimed.

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the grounds that applicant's mark, when used in connection with its services, so resembles each of the following marks, which are owned by different registrants, as to be likely to cause confusion, or to cause mistake, or to deceive: (i) the mark "BUSINESSONE," which is registered for "banking services";² and (ii) the mark "BUSINESS REWARDS," which is registered for "banking services, namely, loan and checking account services to small businesses."³

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusals to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of

² Reg. No. 2,249,644, issued on June 1, 1999, which sets forth a date of first use anywhere and in commerce of March 16, 1998.

³ Reg. No. 2,259,182, issued on July 6, 1999, which sets forth a date of first use anywhere and in commerce of October 16, 1996. The word "BUSINESS" is disclaimed.

confusion analysis, two key considerations are the similarity of the goods and/or services and the similarity of the marks.⁴

Nevertheless, in this case, it is obvious (and applicant does not contend to the contrary) that applicant's "banking services" are identical in their entirety to the "banking services" of one of the registrants and are identical in part (and are otherwise closely related) to the "banking services, namely, loan and checking account services to small businesses" of the other registrant. The respective services, therefore, would in each instance be provided through the same channels of trade to the same classes of customers. Plainly, if rendered under the same or similar marks, confusion as to the source or sponsorship of such services would be likely to occur. The chief focus of our inquiry, therefore, is on whether the marks at issue herein are so similar in their entirety that their contemporaneous use would be likely to cause confusion as to the source or sponsorship of the respective banking services.

As a starting point for consideration of the marks at issue, we note that our principal reviewing court in *Century 21 Real Estate Corp. v. Century Life of America*, 970 F.2d 874, 23 USPQ2d 1698, 1700 (Fed. Cir. 1992), *cert. denied*, 506 U.S. 1034 (1994), indicated that "[w]hen marks would appear on virtually

⁴ The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the

identical goods or services, the degree of similarity [of the marks] necessary to support a conclusion of likely confusion declines." Applicant argues, however, that its mark is not likely to cause confusion with either of the cited marks because, not only are the latter marks weak, in the sense of being highly suggestive of banking services and in common or widespread use,⁵ such that they are only entitled to a narrow scope of protection, but its "three-word mark BUSINESS ONE REWARDS is obviously different from the one-word mark BUSINESSEONE and the two-word mark BUSINESS REWARDS" in sound, appearance, connotation and commercial impression.

In particular, with respect to its mark and the mark "BUSINESSEONE," applicant maintains in its initial brief that:

[T]he phrase "businessone" is ... commonly used and therefore is weak in the trademark sense. Internet searches were performed via Yahoo!, Google, Lycos, as well as Lexis/Nexis. The searches revealed over 80,000 web pages including this phrase and thousands of articles. Referring to the print out of the first 20 pages from Yahoo,

essential characteristics of the goods [and/or services] and differences in the marks."

⁵ Applicant also contends that the copies which it made of record of "the Internet web pages from the web site of the owner of the BUSINESS REWARDS registration" show that such mark "is merely descriptive ... for goods or services involving businesses" in which "rewards are provided to small businesses when the company's financial services are used." However, as correctly noted by the Examining Attorney, a contention that such mark is merely descriptive constitutes an impermissible collateral attack on the validity of the cited registration and will not be entertained in an ex parte appeal. See, e.g., In re Peebles Inc., 23 USPQ2d 1795, 1797 at n. 7 (TTAB 1992); and In re C. F. Hathaway Co., 190 USPQ 343, 345 (TTAB 1976).

it is shown that several sources use the phrase "businessone" in connection with several types of services. The Lexis/Nexis search had to be limited to only current day news stories to produce less than 1,000. In a search of stories published only on May 8, 2002, eleven stories referred to the phrase "businessone." No one can claim exclusive rights in the phrase "businessone." The consumers are accustomed to seeing this phrase in connection with many services and many different sources of services. Therefore, there is no likelihood of confusion between BUSINESS ONE REWARDS and BUSINESSONE.

Furthermore, BUSINESS ONE REWARDS creates a different commercial impression by inclusion of the word "rewards." As noted above, no one can claim exclusive rights to the words or phrase BUSINESSONE, and, therefore, by including the word "rewards," BUSINESS ONE REWARDS is distinguishable from BUSINESSONE. The word "rewards" produces a different sight, sound, and meaning in the mark. BUSINESS ONE REWARDS is a three word mark, rather than the single word format of BUSINESSONE. BUSINESS ONE REWARDS has two additional syllables and is longer. As for meaning, "businessone" has a meaning relating to a business that is superior or at least considered the best. Conversely, BUSINESS ONE REWARDS has a convoluted meaning of a superior reward for a business using the banking services or that a single or primary reward is provided to the business for use of the banking services. Accordingly, BUSINESS ONE REWARDS is different in sight, sound and meaning.

Similarly, as to its mark and the mark "BUSINESS REWARDS," applicant urges that:

The phrase "business rewards" is often used by various sources and, therefore, no one can claim exclusive rights in this

phrase or these words. Searches were performed via Yahoo! and Lycos for the phrase "business rewards." The search[es] revealed over 1,000 Internet web pages that include this common phrase. Referring to the printout of the first 20 hits from either search, it is shown that there are many users of the phrase "business rewards" in connection with financial services, whereby the users provide some sort of benefit or reward for customers using their financial services. The search in Lexis/Nexis revealed over 350 stores [sic] in a 90-day period that referred to the phrase "business rewards." Furthermore, consumers, including small business owners, are well accustomed to seeing this phrase in connection with various services and various sources.

Furthermore, BUSINESS ONE REWARDS is dissimilar from BUSINESS REWARDS in sight, sound and meaning. First, BUSINESS ONE REWARDS is a three word mark, which includes the word ONE between BUSINESS and REWARDS, thus producing a different appearance, sound, and meaning. The inclusion of ONE in the middle of the mark breaks up the commonly used words business and rewards, making it a phrase not commonly used and generating a different commercial impression. A search was performed via Yahoo! and Google, and no web sites were found to include the phrase BUSINESS ONE REWARDS, further showing the difference provided by including the word ONE.

The phrase "business rewards" has a commonly understood meaning, as noted above, relating to a business customer being rewarded for using a service. By including the word "one" between the words business and rewards, the commonly used phrase is broken up and becomes convoluted, such that there is an indication of a superior reward for a business using the service or that a

single or primary reward is provided to the business for the use of the service.

We agree with the Examining Attorney, however, that when the respective marks are considered in their entirety, each of the cited marks is "very similar" to applicant's mark in appearance, sound, connotation and commercial impression. As the Examining Attorney points out, applicant has, in effect, "merely added a term to the registrants' marks," but in each instance the addition thereof "is not sufficient to overcome a likelihood of confusion." Clearly, in the case of the cited mark "BUSINESSONE" and applicant's mark "BUSINESS ONE REWARDS," the addition of the descriptive term "REWARDS" (as evidenced by applicant's disclaimer thereof) is insufficient to distinguish applicant's mark and preclude a likelihood of confusion, given that both marks consist of or are dominated by, respectively, the designation "BUSINESSONE" or "BUSINESS ONE" and are used in connection with identical services, namely, "banking services." Similarly, as to the cited mark "BUSINESS REWARDS" and applicant's mark "BUSINESS ONE REWARDS," the addition of the word "ONE" plainly does not so change applicant's mark in any significant respect as to avoid a likelihood of confusion, inasmuch as the respective services are identical in part and are otherwise closely related. In essence, as summarized in the Examining Attorney's brief, "because the applicant has

appropriated each of the registered marks in their entirety and added a single [descriptive or otherwise inadequately distinguishing] term, the marks are more than sufficiently similar to sustain a finding of likelihood of confusion."

Furthermore, as to applicant's contentions that it has nonetheless shown that the cited marks are weak, and therefore are entitled to only a narrow scope of protection, due to their suggestiveness and common use by third parties, the Examining Attorney properly observes in his brief that:

This argument is meritless because it is not supported by the evidence of record in this case. Search results showing that the terms comprising the registrants' marks may be found in close proximity to one another on the Internet or the Lexis-Nexis database do not in any way establish that the marks are weak in the relevant field. Conversely, the evidence made of record by the previous Examining Attorney shows that ... [the cited] marks are the only registered marks for [identical or closely] related services that include the phrases BUSINESS ONE or BUSINESS REWARDS. This evidence demonstrates that the registrants' marks are not at all weak when used in connection with banking services. Moreover, even if the record did include competent evidence showing that the registrants' marks were weak, they would still clearly be entitled to protection against registration of a highly similar mark for identical services. *King Candy Co. v. Eunice King's Kitchen, Inc.* [,] 182 USPQ 108 (C.C.P.A. 1974).

In particular, we note with respect to the cited "BUSINESSONE" mark that applicant's assertions as to the demonstration of a

plethora of third-party usages are glaringly false. For example, of the 20 "Yahoo!" excerpts, only 15 even use the words "business one" in that order. Of those 15, only two actually use the phrase "Business One" in apparent reference to a business entity (specifically, "Planet Business One" and "Welcome to Business One Inc."), although notably neither reveals any indication as to the nature of the business. The remaining 13 simply use the word "business" followed by the word "one" in a manner other than the phrase "Business One" (e.g., "Home Business One to One Marketing Distributor Opportunity"; "Two young men each launch a business. One rises, the other falls"; and "Botswana Online Edirectory -Business 2 Business one click at a" The seven "Google" excerpts provide similar results, while none of the five "Lexis/Nexis" excerpts show any use of the words "business one." Such evidence clearly fails to establish, as contended by applicant, that "[n]o one can claim exclusive rights in the phrase 'businessone.'"

As to the cited "BUSINESS REWARDS" mark, both "Yahoo!" and "Google" searches confirm that there are no third-party uses of the phrase "business one rewards," which of course applicant uses as its mark. However, while there arguably are a couple of third-party usages, in the 20 "Yahoo!" excerpts, of the term "business rewards" in connection with banking services (e.g., "City Bank e-Business Rewards Program" and "Home Bank | Business

Rewards Investment"), none of the 10 "Lycos" excerpts and none of the nine "Lexis/Nexis" excerpts demonstrate any third-party use of such term in connection with banking services. Instead, when used as the phrase "business rewards," and not merely as the word "business" followed by the word "rewards," most usages of such phrase are in connection with credit card services, airline mileage awards programs, or wireless calling plans. Again, such evidence can hardly be said to demonstrate, as asserted by applicant, that "no one can claim exclusive rights in this phrase or these words," particularly with respect to use of the term "business rewards" in connection with banking services.

In view of the above, and in light of the fact that, as noted by the Examining Attorney, the previous Examining Attorney made of record evidence demonstrating that the cited marks are the only registered marks which, for banking services, include the phrases "BUSINESS ONE" or "BUSINESS REWARDS," it is clear that the registrants' marks are not so weak as to merit only a narrow scope of protection. Therefore, while there are minor differences between applicant's mark and each of the registrants' marks which are apparent upon a side-by-side comparison, such a comparison is not the proper test to be used in determining the issue of likelihood of confusion inasmuch as it is not the ordinary way that customers will be exposed to the

marks. Instead, it is the similarity of the general overall commercial impression engendered by the marks which must determine, due to the fallibility of memory and the concomitant lack of perfect recall, whether confusion as to source or sponsorship is likely. The proper emphasis is accordingly on the recollection of the average purchaser, who normally retains a general rather than a specific impression of marks. See, e.g., *Grandpa Pidgeon's of Missouri, Inc. v. Borgsmiller*, 477 F.2d 586, 177 USPQ 573, 574 (CCPA 1973); *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 733 (TTAB 1981); and *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975). Here, given the substantial overall similarities in appearance, sound, connotation and commercial impression between applicant's "BUSINESS ONE REWARDS" mark for banking services and the cited "BUSINESSONE" mark for banking services, consumers familiar with the latter would be likely, for instance, to believe upon encountering the former that the same source is also providing or sponsoring a new or expanded line of banking services with enhanced features or "rewards." Likewise, in view of the substantial similarities, on the whole, between applicant's "BUSINESS ONE REWARDS" mark for banking services and the cited "BUSINESS REWARDS" mark for banking services, namely, loan and checking account services to small businesses, in terms of appearance, sound, connotation and commercial impression,

customers acquainted with the latter would be likely to view the former as an additional line of expanded or full-feature banking services which emanates from or is associated with the same source.

Applicant, nevertheless, further argues that because consumers of financial services, including banking services, are sophisticated purchasers, there can be no likelihood of confusion in these instances. Applicant asserts, in particular, that "[f]inancial services are not purchased without reflection since they can significantly impact many aspects of an individual's financial security." We recognize, in this regard, that customers for banking services have indeed been regarded as being "expect[ed] to select their bank after long and careful consideration." See, e.g., *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank*, 842 F.2d 1270, 6 USPQ2d 1305, 1308 (Fed. Cir. 1988). However, it is well established, as the Examining Attorney correctly notes, that the fact that customers may exercise deliberation in choosing their banking services "does not necessarily preclude their mistaking one [service mark or] trademark for another" or that they otherwise are entirely immune from confusion as to source or sponsorship. *Wincharger Corp. v. Rinco, Inc.*, 297 F.2d 261, 132 USPQ 289, 292 (CCPA 1962). See also *In re Decombe*, 9 USPQ2d 1812, 1814-15 (TTAB

Ser. No. 76/362,677

1988); and In re Pellerin Milnor Corp., 221 USPQ 558, 560 (TTAB 1983).

Decision: The refusals under Section 2(d) are affirmed.